

## REMARKS

Appellant respectfully disagrees with all of the Examiner's arguments and contentions advanced in Paper No. 14, for at least those reasons originally set forth in Appellant's Brief on Appeal. In this Reply Brief, Appellant highlights for the Honorable Board one specific item from Paper No. 14 which Appellant feels is most errant. Appellant specifically traverses the following statements and arguments made by the Examiner in Paper No. 14, and offers the following rebuttal arguments in support of said traversal:

### Examiner's Statement:

"It is maintained that the original disclosure fails to disclose the claimed combination. The *mere suggestion* that esters according to the invention can be made by the method described in the incorporated reference fails to support the specific fluid composition recited by the instant claims."

(See, Paper No. 14, p. 4, ¶ 11 (*emphasis added*)).

### Rebuttal:

Appellant respectfully submits that the Examiner's characterization of the original disclosure is misguided at best. For the Examiner to refer to subject matter properly incorporated by reference as either "mere suggestion" in relation to an ancillary matter, or as something less than adequate, is improper and flies in the face of established law and regulation for the incorporation of subject matter by reference to an issued U.S. patent.

It is well established that, "the information incorporated [into a specification by reference] is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed." (See, M. P.E.P. §2163.07(b), 8<sup>th</sup> Ed.).

The fact that Appellant has incorporated the referenced U.S. patent into a portion of the Specification directed to the manner in which the esters of the present invention may be

prepared has no bearing on the effect of the incorporated disclosure. Under the law, the entire disclosure of the incorporated reference should be treated as if the text were repeated in the application as filed.

Accordingly, Appellant respectfully submits that the entire disclosure of the incorporated patent, as it pertains to esters of polyols prepared by reacting mixtures of both monocarboxylic and dicarboxylic acids with certain polyols, should be treated as if it were presented verbatim in the instant application on appeal. Thus, it is respectfully submitted that the Specification of the instant application on appeal contains adequate disclosure relating to polyol esters prepared using mixtures of monocarboxylic and dicarboxylic acids. Furthermore, Appellant respectfully submits that one of ordinary skill in the art would readily recognize that the combinations of monocarboxylic and dicarboxylic acids discussed in the incorporated reference could be used in conjunction with any of the disclosed embodiments set forth in the Specification of the instant application on appeal, without having to have referenced the incorporated patent in each instance.

#### CONCLUSION

Appellant respectfully requests that the Honorable Board consider the rebuttal presented above, and find for Appellant, reversing the Examiner's final rejection.

Respectfully submitted,

**EUGENE R. ZEHLER**

April 26, 2004  
(Date)

By: \_\_\_\_\_

Aaron R. Ettelman  
**AARON R. ETTELMAN**

Registration No. 42,516

**COGNIS CORPORATION**

300 Brookside Avenue

Ambler, PA 19002

Telephone: (215) 628-1413

Facsimile: (215) 628-1345

E-Mail: AARON.ETTELMAN@COGNIS-US.COM

ARE:are